

REMARKS

The Office Action dated October 11, 2005, has been received and carefully considered. In this response, claims 20, 21, 30, 33, 37, 44-47, 49-52, 54, 57 and 62-63 have been amended. Entry of the amendments to claims 20, 21, 30, 33, 37, 44-47, 49-52, 54, 57 and 62-63 is respectfully requested. Reconsideration of the outstanding objections/rejections in the present application is also respectfully requested based on the following remarks.

I. THE OBJECTION TO THE SPECIFICATION

On page 2 of the Office Action, the specification was objected to as failing to provide antecedent basis for the claimed subject matter. In particular, the Office objects to the specification for failing to provide proper antecedent basis for the term “stored value card,” as required by 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The Office asserts that the specification uses the term “purchase card” instead of “stored value card” and requests appropriate correction. This objection is respectfully traversed.

Applicants respectfully submits that, as stated in MPEP § 2163.02, the fundamental factual inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed. The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. Moreover, Applicants note that the application as originally filed does, indeed, recite a “stored value card.” First, the title of the application as originally filed is “Debit purchasing of *stored value card* for use by and/or delivery to others” (emphasis added). The Field of the Invention also recites “This invention relates to a system for purchasing or transferring of *stored value* or debit purchasing *cards*, which can be pre-arranged to be given as a gift to a designated recipient” (emphasis added).

For at least these reasons, Applicants respectfully request that the instant objection be withdrawn.

II. THE INDEFINITENESS REJECTION OF CLAIMS 33 AND 63

On page 2 of the Office Action, claims 33 and 63 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. This rejection is hereby respectfully traversed.

Applicant has amended claims 33 and 63 to recite, respectively: “a card issued by an issuer, the card being unactivated” and “a stored value card issued by an issuer.” Applicant respectfully submits, however, that claim 33’s recital of a “card processing center” is not improper. Applicant respectfully submits that the specification clearly supports such a term. *See, e.g.*, Page 5, ¶0027 (The offer may be accepted by a purchaser 105 by notifying a customer service center 110.”)

In view of the foregoing, it is respectfully requested that the aforementioned indefiniteness rejection of claims 33 and 63 be withdrawn.

III. THE ANTICIPATION REJECTION OF CLAIMS 20-23, 25-39, 44-47, 49-52, 54-57, 59, 60, 62 AND 63

On page 3 of the Office Action, claims 20-23, 25-39, 44-47, 49-52, 54-57, 59, 60, 62 and 63 were rejected under 35 U.S.C. § 102(e) as being anticipated by Albrecht (U.S. Patent No. 5,984,180). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. *Id.* “In addition, the prior art

reference must be enabling.” Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his own knowledge to make the claimed invention.” Id..

The Examiner asserts that Albrecht discloses a method for using a stored value card having associated card identification data comprising, among other things, the step: “wherein the identifier, the card identifier data, and a card value amount are stored in a card account accessible by the card processing center (Col. 5, line 14 through Col. 6, lines 65).”

Although Applicant does not agree with the pending rejection, Applicant has nonetheless amended the claims to clarify the claimed systems and methods and better distinguish the cited references. In particular, Applicant has amended each of independent claims 20, 30, 33, 37, 44-47, 49-52, 54, 57 and 62-63 to recite “an independent account.” Claim 20, for example, now recites: “wherein the identifier, the card identification data, and a card value amount are stored in [[a]] an independent card account accessible by the card processing center.”

Applicant respectfully submits that Albrecht does not teach or suggest any feature or functionality comprising an independent account, as that term is used in the pending claims. Rather, Applicant respectfully submits that Albrecht discloses a secondary account that is dependent on a credit account:

A method and system for providing purchasable value for gifts and other uses in the form of a credit instrument is provided. *A purchaser of a gift credit instrument authorizes a credit institution with which the purchaser holds a credit account to create a limited-value, non-renewable secondary account*

linked exclusively to the purchaser's credit account. A credit instrument is issued to an authorized user which credit instrument uniquely identifies the secondary account. The gift credit instrument may be used in the same manner as the purchaser's credit instrument; however, it expires after a certain period of time or after the initial value of the secondary account is spent. A system for carrying out the method is also provided.

See Abstract, Albrecht (emphasis added).

Applicant respectfully submits that there is not teaching or suggestion, whatsoever, that Albrecht's disclosed "secondary account" can be anything other than an account that is "secondary" to another account. Rather, the existence of Albrecht's gift credit card account depends completely on the existence of the primary account. Without the primary account, the secondary account could not be "linked exclusively to the purchaser's credit account."

Applicant respectfully submits that Albrecht requires linkage to a primary account in order to achieve the various advantages and functionality of Albrecht's invention. For instance, the Albrecht system is configured so that the secondary gift credit card account is funded exclusively through the primary account. In one embodiment of Albrecht's funding scheme, purchases made using the secondary gift credit card account are posted to (and paid for by) the primary account on an ongoing basis. This requires the two accounts to be directly linked on an ongoing basis as additional transactions are posted. Thus, for at least this reason, Albrecht fails to teach or suggest the "independent account" recited in independent claims 20, 30, 33, 37, 44-47, 49-52, 54, 57 and 62-63 are allowable over Albrecht.

Claims 21-23, 25-29, 31-32, 34-36, 38-39, 55-56 and 58-61 are dependent upon independent claim 20, 30, 33, 37, 44-47, 49-52, 54 or 57. Thus, since independent claim 20, 30, 33, 37, 44-47, 49-52, 54 and 57 should be allowable as discussed above, claims 21-23, 25-29, 31-32, 34-36, 38-39, 55-56 and 58-61 should also be allowable at least by virtue of their dependency on independent claim 20, 30, 33, 37, 44-47, 49-52, 54 or 57. Moreover, these claims

recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. For example, claim 21 recites the method of claim 20 “further comprising the step of establishing the independent card account at the card processing center, the account being uniquely associated with the card.” Applicant respectfully submits that Albrecht does not teach or suggest any feature or functionality comprising “establishing the independent card account at the card processing center, the account being uniquely associated with the card,” as recited in claim 21.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 20-23, 25-39, 44-47, 49-52, 54-57, 59, 60, 62 and 63 be withdrawn.

IV. THE OBVIOUSNESS REJECTION OF CLAIMS 58 AND 61

On page 16 of the Office Action, claims 58 and 61 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Albrecht. This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the obviousness rejection of claims 58 and 61 has been overcome by the amendment to claim 57 and the remarks set forth above in connection with the anticipation rejection of claims 20-23, 25-39, 44-47, 49-52, 54-57, 59, 60, 62 and 63.

Further, the Applicant respectfully traverses this rejection because there is no support in the record for the conclusion that the identified features are “old and well known.” In accordance with MPEP § 2144.03, the Examiner must cite a reference in support of her position.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 58 and 61 be withdrawn.

V. THE DOUBLE PATENTING REJECTION OF CLAIMS 20-23, 25-39, 44-47, 49-52 AND 54-63

On pages 17-18 of the Office Action, Claims 20-23, 25-39, 44-47, 49-52 and 54-63 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-21 and 38-42 of U.S. Patent No. 6,615,189. Claims 20-23, 25-39, 44-47, 49-52 and 54-63 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,892,187.

A timely filed terminal disclaimer is hereby filed herewith to overcome this rejection.

VI. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

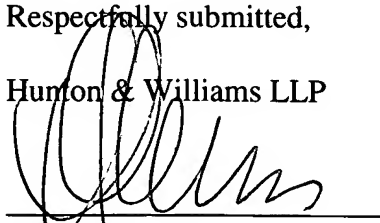
To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper,
including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess
fees to the same deposit account.

Respectfully submitted,

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